

REMARKS

Claims 1 – 26 remain in the application and stand rejected. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2197.

It is asserted that claims 1, 2, 4, 5, 10 – 13, 18, 19, 21 and 22 are unpatentable under 35 U.S.C. §102(b) over U.S. Patent No. 5,095,500 to Tayloe et al. It is also asserted that claims 1, 2, 4, 5, 10 – 13, 18, 19, 21 and 22 are unpatentable under 35 U.S.C. §102(e) and claims 3 and 20 are unpatentable under 35 U.S.C. §103(a) over published U.S. Patent Application No. 2002/0009992 to Jenson alone. It is further asserted that claims 6 – 9, 14 – 17, and 23 – 26 are unpatentable under 35 U.S.C. §103(a) over Jenson in combination with U.S. Patent No. 6,677,894 to Sheynblat et al.

Essentially, it is asserted that Talyoe et al. and Jenson teach the invention as recited in claims 1, 2, 4, 5, 10 – 13, 18, 19, 21 and 22, and further that Jenson suggests claims 3 and 20. Sheynblat et al. is cited for teaching providing location specific information as recited in claims 6 – 9, 14 – 17, and 23 – 26. The rejection is respectfully traversed.

Tayloe et al. teaches a communication system with base stations 101, 106, 111 in Figure 1, wherein “each **base station** is equipped with a locator 103, 108, and 113 which employs signal strength measurements and timing advance techniques for locating and tracking the position of mobile units engaged in active calls.” Col. 3, lines 46 – 50 (emphasis added). The base stations 101, 106, 111 use triangulation to determine mobile unit 100 positions. Col. 3, lines 51 – 65. Mobile units 100 measure signal strength and quality and forward the measurements to a server base station. Col. 4, lines 8 – 12.

Jenson teaches a wireless network that “can determine the location of a mobile unit 17 or 19 through **triangulation** of that unit with reference to one or more towers in the wireless system. The process of location determination is **referred to as geolocation.**” Paragraph 0037,

(emphasis added). “The **wireless system will determine** the difference in the arrival time at each of the towers and determine the relative distance of the mobile unit 17 from each tower. The **wireless system can** apply the determined relative distances to **triangulate the location of the mobile unit 17.**” *Id.*

Sheynblat et al. teaches “distributing location-based information (i.e., information specific to a client's location or a location of interest to the client) to a client,” and “based on the information, provides via the Internet information relating to the client's location or location of interest to the client.” Col. 3, lines 35 – 47. The client may be a cell phone with a GPS receiver and the information may be retrieved over the Internet. Col. 5, lines 18 – 23 and col. 7, lines 17 – 24.

The present invention, as recited in claim 1, is a wireless communications network with “a base transceiver station (BTS) in each said network cell;” and “a positioned MS unit selectively providing located reception measurements to said BTS, located reception measurements including a current MS unit location with current signal reception measurements.” A positioned MS unit includes a position location receiver. Claim 11 includes corresponding recitations. Claim 19 recites “measuring signal reception level at a Mobile Subscriber (MS) unit;” and “providing measured said reception level and said located position to a base transceiver station (BTS);...” Thus, it is the positioned MS unit that determines and provides current MS unit location and current signal reception measurements, not the BTS. In particular, “(m)obile network positioning in combination with GPS positioning serves to provide any particular GP-MS user that is within the network reception area with positional accuracy to within 1m.” Page 3, lines 28-31, *and see, e.g.*, claims 4 and 18. Furthermore, each active GP-MS seamlessly and automatically passes positional information with the same positional accuracy to the BTS. Page 3, line 31 – page 4, line 1 *and see, e.g.*, claim 21.

Since Tayloe et al. teaches a wireless network wherein a BTS uses triangulation (geolocation) to determine the location of mobile units and to measure signal strength of each, Tayloe et al. does not result in the present invention as claimed in any of claims 1, 11 or 19 or in any claims depending therefrom. Likewise, since Jenson teaches a wireless network wherein a

BTS uses triangulation (geolocation) to determine the location of mobile units, Jenson does not result in the present invention as claimed in any of claims 1, 11 or 19. Reconsideration and withdrawal of the rejection of claims 1, 11, and 19 over Tayloe et al. under 35 U.S.C. §102(b) and Jenson under 35 U.S.C. §102(e) is respectfully solicited.

Since dependent claims include all of the differences with the references as the claims from which they depend, neither Taloe et al. or Jenson teaches or suggests the present invention as recited in claims 2 – 5, 10, 12, 13, 18 or 20 – 22, which depend from independent claims 1, 11, and 19. Reconsideration and withdrawal of the rejection of claims 2, 4, 5, 10, 12, 13, 18, 21 and 22 over Tayloe et al. under 35 U.S.C. §102(b) and of claims 2 – 5, 10, 12, 13, 18, and 20 – 22 over Jenson under 35 U.S.C. §§102(e) and 103(a) is respectfully solicited.

Regarding the rejection of claims 6 – 9, 14 – 17, and 23 – 26 over the combination of Sheynblat et al. with Jenson; combining the Sheynblat et al. wireless distribution of location-based information the Jenson network does not result in the present invention as recited in claims 1 – 5, 10 – 13, or 18 – 22, much less as recited in claims 6 – 9, 14 – 17, and 23 – 26. Instead, the allegedly obvious combination of distributing location-based information as taught by Sheynblat et al. with the base station triangulation of Jenson results in a wireless network that uses geolocation to determine the location of mobile units and distributes location-based information to the mobile units based on the respective geolocation of each.

With respect to the suggestion to combine, it is asserted that “it would have been obvious to one of ordinary skill in the art to modify Jensen to include Sheynblat as providing location specific information to positioned mobile units is well known in the art to provide convenient information to the mobile unit user.” That something could be done does not make it so. Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 at 1432 (Fed. Cir. 1990).

Many of the best inventions invoke the exclamation that “it seems so obvious. Why didn’t I think of that?” Thus, obviousness is based on a legal standard, not what one may feel

with respect to the particular invention. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). An obviousness rejection cannot be based on the resort to various references and the combination of bits and pieces of the references in the light of Applicants’ teachings. An extensive discussion of the criteria to be applied in obviousness rulings is set forth in Aqua-Aerobic Systems Inc. v. Richards of Rockford Inc., 1 U.S.P.Q. 2d 1945, 1955-57 (N.D. Ill. 1986). “The fact that a prior art reference can be modified to show the patented invention does not make the modification obvious unless the prior art reference **suggests the desirability** of the modification. An attempted modification of a prior art reference that is unwarranted by the disclosure of that reference is improper.” In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (emphasis added).

The MPEP §2143.01 provides in pertinent part that the

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some **objective reason** to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also... ; Al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). (Emphasis added.)

While there is no requirement that “an express written motivation to combine must appear in prior art references,” the references must implicitly suggest the combination, e.g., be directed to precisely the same problem. Ruiz v. A.B. Chance Co., 357 F.3d 1270, 69 USPQ2d 1686 at 1690 (Fed. Cir. 2004). Accordingly, since no such objective reason to combine is indicated in any reference of record, regardless of the result of such a combination, there is no

suggestion to combine in the record. Accordingly because the allegedly obvious combination does not result in the present invention and because the references of record do not suggest the combination, the present invention is not obvious over the references of record. Reconsideration and withdrawal of the rejection of claims 6 – 9, 14 – 17, and 23 – 26 over Jenson in combination with Sheynblat et al. under 35 U.S.C. §103(a) is respectfully solicited.

The applicants have considered the other references cited but not relied upon and find them to be no more relevant than the references upon which the Examiner relied for the rejection.

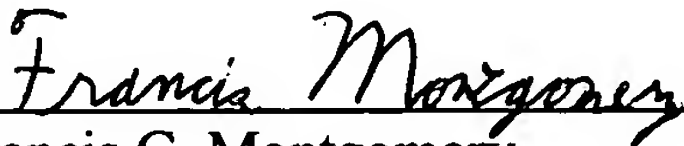
The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 – 26 under 35 U.S.C. §§102(a), (e) and 103(a) and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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